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| 10/608,041 | 06/30/2003 | Akihiko Fujiwara | 047373-0131 | 7175 |
| 22428 | 7590 | 09/22/2005 | EXAMINER | |
| FOLEY AND LARDNER SUITE 500 3000 K STREET NW WASHINGTON, DC 20007 | | | FABER, DAVID | |
| | | | ART UNIT | PAPER NUMBER |
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DATE MAILED: 09/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/608,041

Applicant(s)

FUJIWARA, AKIHIKO

Examiner

David Faber

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2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 and 24-41 is/are rejected.
- 7) ☒ Claim(s) 19-23 and 42-46 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 June 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This office action is in response to the application filed 30 June 2003 and the Information Disclosure Statement filed 24 October 2003.

This action is made Non-Final.

2. Claims 1-46 are pending in the case. Claims 1 and 24 are independent claims.

Information Disclosure Statement

3. The information disclosure statement (IDS) submitted on 24 October 2003 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Drawings

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: document management database 20, paragraph 0021, line 2. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective

action in the next Office action. The objection to the drawings will not be held in abeyance.

5. The drawings are objected to because the word "related" is spelled incorrectly in Fig. 5B, block 512 and Fig. 6, block 612. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-2, and 24-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Matsumoto (US Patent 5,897,643, patented 4/27/1999).

As per independent Claim 1, Matsumoto discloses a method for managing documents comprising:

- Storing a first document having a first style in a document repository. (Fig. 1, block 16; Column 3, lines 26-27 – external memory device for storing electronic data of documents)
- Creating an identification (ID) associated with the first document (Fig. 1, block 20; e.g. Fig. 4)
- providing a discernment Information table, the discernment information table including the ID associated with the first document; and (e.g. Column 4, lines 12-24 – disclosed as an ID table)
- providing a related information table, the related information table including the ID and related information of the first document, the related information including at least an operational history of the first document. (e.g. Column 4, lines 25-39 – disclosed as a link information table)

As per dependent Claim 2, Matsumoto discloses the method of Claim 1:

- wherein the discernment information table further includes a name of the first document. (Column 4, line 18)

As per independent Claim 24, the applicant recites the system for performing the method of Claim 1. Therefore, Claim 24 is similarly rejected under Matsumoto.

Furthermore, applicant discloses a processor, wherein the processor is configured to perform the claims disclosed in Claim 1, and memory, wherein coupled to the processor and containing a discernment information table and related information table.

Matsumoto discloses that his system comprises of a client and a server, wherein each the client and the server are both configured by a personal computer, both containing an external memory device. (FIG 1). Since the client and the server are both personal computers, one in the well-known art would know that a processor is inherently present to perform the functionality of the system disclosed. In addition, the external memory device is connected to each of the computers; (FIG 1) therefore, linked to the processor to perform the functionality of the hardware. Furthermore, the external memory device connected to the server contains the ID table (discernment information table), and link information table (related information table). (Column 4, lines 7-11)

As per independent Claim 25, the applicant recites the system for performing the method of Claim 2. Therefore, Claim 25 is similarly rejected under Matsumoto.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 3-8, 10, 15-17, 26-31, 33, and 38-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsumoto (US Patent 5,897,643, patented 4/27/1999).

As per dependent Claim 3, Matsumoto discloses the method of Claim 2 further comprising:

- translating the first document to create a second document having a second style different from the first style; (FIG 5 and 6)

Incorporating Matsumoto copy and updating functions together can perform this function. Matsumoto can copy a document, which creates a second document, then update the second document to produce a different style.

- updating the discernment table to include a name of the second document
- modifying the related information table to include related information of the second document, the related information of the second document including at least an operational history of the second document.

Performing the explanation above the ID table (discernment table) is updated with the new relevant document information (Column 5, lines 49-56, and Column 6, lines 10-14), and the link information table (related information table) is update with the new relevant document information (Column 6, lines 19-26)

Matsumoto fails to specifically disclose that the second document is associated with the ID from the first document. However, Matsumoto discloses a document copy-relationship method in which each new document generated, e.g. copying, is associated

with a new ID so it can keep track of updates of document contents and changes of location, whether contents of the original document and the copy document are identical, and where each of the documents are saved. (Column 1, lines 25-45)

It would have been obvious to one of the ordinary skill in the art at the time of the applicant's invention to incorporate Matsumoto's document copy-relationship method by using the same ID to keep track of each of the document operations since it would save cost and resources for storing only one ID instead of multiple IDs referring to the same document through different operations.

As per dependent Claim 4, Matsumoto discloses the method of Claim 3:

- wherein the second style is different from the first style based on a different method of storing the first and second documents, respectively.

(Fig 12 – user has the ability to print out the first document thus creating a second document)

As per dependent Claim 5, Matsumoto discloses the method of Claim 3:

- wherein the second style is different from the first style based on different forms of the first and second documents, respectively.

(Column 8, lines 15-16; user has ability to have an electronic data document and a paper form document)

As per dependent Claim 6, the applicant discloses the limitations similar to those in Claim 3. Claim 6 is similar rejected under Matsumoto.

As per dependent Claim 7, Matsumoto discloses the method of Claim 6:

- wherein the step of translating the first document to create the second document includes printing a copy of the first document onto a medium to create the second document, and wherein the step of associating the ID with the second document includes printing the ID as an ID identifier onto the medium.

(FIG 12 and Column 8, 27-65 – Matsumoto discloses that the document ID is attached when the document is printed out to a paper-form medium. Therefore, the printed paper-medium document has the ID printed on the document.) In addition, associating the ID with the second document is rejected under rationale of Claim 3.

As per dependent Claim 8, Matsumoto discloses the method of Claim 7:

- wherein the medium is one of paper and a transparency. (Column 8, line 39)

As per dependent Claim 10, Matsumoto discloses the method of Claim 7 further comprising:

- scanning the medium to translate the second document to create a third document having a third style different from the second style; (Column 8, lines 64-66)
- reading the ID identifier (Column 9, lines 10-11);
- updating the discernment information table to include a name of the third document; and (Column 9, lines 1-4)
- modifying the related information table to include related information of the third document, the related information including at least operational history of the third document. (Column 9, lines 1-4).

In addition, associating the ID with the third document is rejected under rationale of Claim 3.

As per dependent Claim 15, Matsumoto discloses the method of Claim 3 further comprising:

- modifying the operational history of a document in the related information table to indicate a document has been deleted. (Column 12, Claim 16)

Matsumoto fails to specifically disclose that the first document is deleted after the second document has been created. However, Matsumoto discloses an editing operation of a document that updates the ID table and the link information table when a deletion of a document has occurred. (Column 7, lines 29-37)

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have known that Matsumoto's method includes an option to delete an original document once duplicated since both tables perform updates of deletion when the transaction occurs.

As per dependent Claim 16, Matsumoto discloses the method of Claim 15 further comprising:

- translating the second document to create a third document having a third style different from the second style; (Column 8, lines 64-66 – paper medium to an electronic document)
- taking an electronic action based on the first document being deleted. (Claim 15)

In addition, associating the ID with the third document is rejected under rationale of Claim 3.

As per dependent Claim 17, Matsumoto discloses the method of Claim 16:

- wherein the electronic action comprises at least one of displaying a message indicating that the first document has been deleted and registering the third document as a new document. (Claim 12)

As per independent Claim 26, the applicant recites the system for performing the method of Claim 3. Therefore, Claim 26 is similarly rejected under Matsumoto.

As per independent Claim 27, the applicant recites the system for performing the method of Claim 4. Therefore, Claim 27 is similarly rejected under Matsumoto.

As per independent Claim 28, the applicant recites the system for performing the method of Claim 5. Therefore, Claim 28 is similarly rejected under Matsumoto.

As per independent Claim 29, the applicant recites the system for performing the method of Claim 6. Therefore, Claim 29 is similarly rejected under Matsumoto.

As per independent Claim 30, the applicant recites the system for performing the method of Claim 7. Therefore, Claim 30 is similarly rejected under Matsumoto.

As per independent Claim 31, the applicant recites the system for performing the method of Claim 8. Therefore, Claim 31 is similarly rejected under Matsumoto.

As per independent Claim 33, the applicant recites the system for performing the method of Claim 10. Therefore, Claim 33 is similarly rejected under Matsumoto.

As per independent Claim 38, the applicant recites the system for performing the method of Claim 15. Therefore, Claim 38 is similarly rejected under Matsumoto.

As per independent Claim 39, the applicant recites the system for performing the method of Claim 16. Therefore, Claim 39 is similarly rejected under Matsumoto.

As per independent Claim 40, the applicant recites the system for performing the method of Claim 17. Therefore, Claim 40 is similarly rejected under Matsumoto.

10. Claims 9 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsumoto (Patent 5,897,643, patented 4/27/1999) and further in view of Hyakutake et al (US PGPub 20020114013, filed 2/20/2001).

As per dependent claim 9, Matsumoto fails to specifically disclose stating the ID identifier is one of a bar code and an electronic watermark. Hyakutake et al discloses a document can be merged with watermark information and be transmitted to a printer for printing. (paragraph 0029)

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to combine Matsumoto's method with Hyakutake et al's method since it would have allowed a user to store an identification identifier and information relating to the document securely.

As per independent Claim 32, the applicant recites the system for performing the method of Claim 9. Therefore, Claim 32 is similarly rejected under Matsumoto and Hyakutake et al.

11. Claims 11-14 and 34-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsumoto (US Patent 5,897,643, patented 4/27/1999) and further in view of Kubota et al (US PGPub 6819806, filed 3/3/2000).

As per dependent Claim 11, Claim 11 recites similar limitations as in Claim 10 and is rejected under rationale. Furthermore, Matsumoto discloses the method of claim 7 further comprising:

- scanning the medium to translate the second document to create a third document having a third style different from the second style; (Column 8, lines 64-65)
- reading the ID identifier; (Column 8, lines 64-65)
- updating the discernment information table to include a name of the third document and (Column 9, lines 1-4)
- modifying the related information table to include related information of the third document, the related information including at least operational history of the third document and indicating that the third document is a modified version of the first document. (Column 9, lines 1-4)

Matsumoto fails to specifically disclose that the document is modified prior to scanning. However, it was well-known to one of the ordinary skill in the art that a physical document on a paper medium can be modified or edit and be scanned for further process. Examples of this method include form filling on a paper medium, scanned, and imported into database.

It would have obvious to one of the ordinary skill in the art at the time of the applicant's invention to have combine Matsumoto's method with scanning modified documents on a paper medium to allow a more efficient and effective way of comparing documents and updating databases.

In addition, Matsumoto fails to specifically disclose that his method compares the first document to the third document and determine if the medium has been modified. However, Kubota et al discloses a method of comparing an original document to a modified document and determines if the new document had been modified. (Column 4, lines 18-65; Fig. 6)

It would have been obvious to one of the ordinary skill in the art at the time of the applicant's invention to have combine Matsumoto's method with Kubota et al method, since it would have allowed a user to be provided with a useful and convenient document management process on updating documents automatically.

In addition, associating the ID with the third document is rejected under rationale incorporated of Claim 10.

As per dependent Claim 12, Claim 12 recites similar limitations as in Claim 11 and is rejected under rationale. Matsumoto fails to specifically disclose of extracting the modified portion of the third document after comparing to the first document and displaying the extracted portion. However, Kubota et al discloses that the information that been modified is extracted to the screen when comparing it to the original document. (Fig 7)

It would have been obvious to one of the ordinary skill in the art at the time of the applicant's invention to have combine Matsumoto's method with Kubota et al's method since it would have allowed the user to proofread the extracted information prior to updating the original document.

As per dependent Claim 13, Claim 13 recites similar limitations as in Claim 11 and is rejected under rationale. Furthermore, Matsumoto discloses the method of claim 11: wherein the first document has a first document form and the third document has a third document form different from the first document form, and wherein the step of comparing the first document with the third document includes converting the first document into the third document form.

Matsumoto discloses that an electronic data document can be printed out onto a paper medium (FIG 12). In addition, Matsumoto discloses that the paper medium may be read with the scanner and copied as an electronic-data document. It was well known in the art that prior of a scanned document being saved as an electronic data document, such by an OCR process, it is scanned as an image viewing form to displayed to the screen. Therefore, the scanned document, the third document in this case, would be in a different form than the first document. Furthermore, based on the rejection of comparing in claim 11, and the rationale incorporated within, the step of comparing including converting is rejected based on the rationale expressed in the conversion reason stated above.

As per dependent Claim 14, Claim 14 recites similar limitations as in Claim 13 and is rejected under rationale. Furthermore, Matsumoto discloses the method of claim 13: wherein the third document form is a bit map form.

Based on the rejection of the third document being in a different form in Claim 13 and the rationale incorporated within, the printed document scanned must be converted into an image viewable form, or a bit map form, in order to be displayed onto the screen or printed as a hard copy.

As per independent Claim 34, the applicant recites the system for performing the method of Claim 11. Therefore, Claim 34 is similarly rejected under Matsumoto and Kubota et al.

As per independent Claim 35, the applicant recites the system for performing the method of Claim 12. Therefore, Claim 35 is similarly rejected under Matsumoto and Kubota et al.

As per independent Claim 36, the applicant recites the system for performing the method of Claim 13. Therefore, Claim 36 is similarly rejected under Matsumoto and Kubota et al.

As per independent Claim 37, the applicant recites the system for performing the method of Claim 14. Therefore, Claim 37 is similarly rejected under Matsumoto and Kubota et al.

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12. Claims 18 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsumoto (US Patent 5,897,643, patented 4/27/1999) and further in view of Matsumoto (US PGPub 20010003819, filed 11/29/2000).

As per dependent Claim 18, Matsumoto (Patent '643) fails to specifically disclose that:

- associating with a first user creating the first document, a first authority level and a second authority level;
- associating with a second user creating the second document, the first authority level;
- wherein the first and second authority levels grant access to related information of the first and second documents in the related information table; and
- wherein the first authority the second document in the related level grants access to related information of information table, but not access to related information of the first document in the related information table.

However, Matsumoto (PGPub '819) discloses a security system for controlling electronic documents through the means of access authority. In order to access or update a document in Matsumoto's (PGPub '819) method, the system must authorize or grant the user's permission in order to access the file (paragraph 0066) based on the control information of the document set by the owner (paragraph 0024). In addition, Matsumoto states the information of the control table most likely controls the access authority information (paragraph 0062).

It would have been obvious to one of the ordinary skill in the art at the time of the applicant's invention to have combined Matsumoto's (Patent '643) method of document management system with Matsumoto's (PGPub '819) method of access authority control since it would have allowed the system to be effective in managing document and secured on accessibility of its documents.

As per independent Claim 41, the applicant recites the system for performing the method of Claim 18. Therefore, Claim 41 is similarly rejected under Matsumoto (Patent '643) and Matsumoto (PGPub '819).

Allowable Subject Matter

13. Claims 19-23 and 42-46 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Shiman et al (US PGPub 20020019827 A1): Discloses centralized document repository system.
- Kagimasa et al (US PGPub 20020078104 A1): Discloses document information management system.

- Takahashi et al (US PGPub 20020065853 A1): Discloses updating electronic source file based on edits on printouts.
- Kanchirayappa et al (US Patent 6895500): Discloses PDF document management system.
- Wang (US Patent 5414844): Discloses control of public access within a data processing system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Faber whose telephone number is 571-272-2751. The examiner can normally be reached on M-F from 8am to 430pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong, can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David Faber
Examiner
Art Unit 2178



STEPHEN HONG
SUPERVISORY PATENT EXAMINER